



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,054	01/28/2004	Larry C. Wortham	074073.0107	2314

5073 7590 07/13/2006

BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
SUITE 600  
DALLAS, TX 75201-2980

EXAMINER
----------

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/766,054

Applicant(s)

WORTHAM, LARRY C.

Examiner

Jean A. Gelin

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 07, 2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that the recitation that an element is "operable to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In view of the 112 rejection above claims 9-24 are rejected as follow:

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2617

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9-10, 12, 15-18, 20, 23, 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Tendler (US 2004/0176106).

Regarding claims 9 and 17, Tendler teaches a device for determining the location of a communication device (using DTMF tone to transmit location coordinate of the wireless phone, section 16) comprising: a network interface, operable to receive a location message comprising a plurality of signal tones (locator module 16 receives location information via the GPS antenna, sections 17-18, 29); a signal enhancement module operable to modify a selected subset of the plurality of signal tones, wherein the selected subset comprises signal tones having a frequency within a predetermined range of frequencies (DTMF tone is modified by an audio amplifier, section 29); a tone decoder operable to decode the modified signal tones into a plurality of decoded values (decoder, sections 29, 33); and a translator determining a location of a user based on at least the plurality of decoded values (sections 18, 29, and 33-34).

Regarding claims 10, and 18, Tendler teaches wherein modifying the volume of selected signal tones comprises setting the volume of the selected signal tones to a predetermined value (i.e., DTMF tone is amplified by an audio amplifier, sections 29, 33-34).

Art Unit: 2617

Regarding claims 12, and 20, Tendler teaches generating a location output that includes the location of the user and conforms to National Marine Electronics Association Standard 1083 ("NMEA-1083") (section 33).

Regarding claims 15, and 23, Tendler teaches wherein the plurality of signal tones comprise a plurality of Dual Tone Multifrequency (DTMF) tones, the DTMF tones identifying the location of a position locating device communicated through a mobile communication device (sections 29, 33-34).

Regarding claims 16, and 24, Tendler teaches wherein the location message comprises a plurality of DTMF tones and wherein receiving a location message comprises: receiving voice communication on a voice channel established between the user and the operator (sections 29, 33), and receiving simultaneously the location message on the voice channel (sections 29, 33).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler in view of Cooper et al. (US 3,906,166).

Regarding claims 11, 19, Tendler teaches all the limitations above except wherein modifying the volume of selected signal tones comprises: increasing a volume

Art Unit: 2617

of each selected signal tone for which the volume is below a predetermined minimum, and decreasing a volume of each selected signal tone for which the volume is above a predetermined maximum.

However, the preceding limitations are known in the art of communications. Cooper teaches the automatic output control increases output power when tone is absent and gradually decreases output when tone is present (col. 10, lines 15-29). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Cooper within the system of Tendler in order that the output power is always maintained at an optimum power.

8. Claims 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler in view of Toxler. (US 2002/0196151).

Regarding claims 13, and 21, Tendler teaches all the limitations above except generating a location output that includes the location of the user and conforms to the SiRF binary protocol.

However, the preceding limitation is known in the art of communications. Toxler teaches an external controller communicates with the GPS receiver via the SiRF binary protocol which can be used to control AT command Firmware (sections 45 and 55). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the techniques of Toxler within the system Tendler in order that the GSM controller can control the sending of the AT commands through the configuration protocol.

Art Unit: 2617

9. Claims 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tendler in view of Brown (US 5,742,987).

Regarding claims 14, and 22 Tendler teaches all the limitations above except signal tones have frequencies between 300 and 3500 Hz.

However, the preceding limitation is known in the art of communications. Brown teaches sending signal tones to each transmit site on a dedicated stable T1-type channel over the inter-site communication links; a lower signal tone (e.g., 300 HZ is used as a gating and higher signal tone (2400 HZ) is used as a clocking frequency reference (i.e., between 300-3500 HZ), col. 4, line 54 to col. 5, line 10). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Brown within the system of Tendler in order to resynchronize transmission data at each transmitter site and correct control channel timing errors that may arise.

#### ***Allowable Subject Matter***

10. Claims 1-8 are allowed.

#### ***Response to Arguments***

11. Applicant's arguments filed June 07, 2006 have been fully considered but they are not persuasive.

The Applicant further argues that claims 9 and 17 are allowable for the same reasons recited in claim 1. However, claim 9 and 17 contains an element that is

Art Unit: 2617

operable to perform certain function, which renders the claims vague and indefinite.

Therefore, the scope of claims 9 and 17 are indefinite. Therefore, the Examiner has interpreted and rejected claims 9-24 as recited above.

It has been held that the recitation that an element is "operable to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

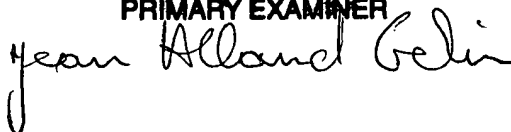


Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JGelin  
July 9, 2006

**JEAN GELIN**  
**PRIMARY EXAMINER**

A handwritten signature in black ink that reads "jean Allard Gelin". The signature is written in a cursive, flowing style.